

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

555255-012558

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on December 11, 2009

Signature

*Debra Pejeau*

Typed or printed name Debra Pejeau

Application Number

10/788870

Filed

27-Feb-2004

First Named Inventor

Vadim Fux

Art Unit

2178

Examiner

Manglesh M. Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Joseph M. Sauer/

Signature

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Joseph M. Sauer

Typed or printed name

☒ attorney or agent of record.  
Registration number 47,919

216-586-7506

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

December 11, 2009

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 555255-012558

Group Art Unit:	2178	)	
		)	
Examiner:	Manglesh M. Patel	)	
		)	
Inventor:	Fux, et al.	)	
		)	
Serial No.:	10/788,870	)	<b>REQUEST FOR PRE-APPEAL</b>
		)	<b>BRIEF PANEL REVIEW</b>
Filed:	February 27, 2004	)	
		)	
For:	Font Data Processing System	)	
	and Method	)	
		)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Examiner has finally rejected claims 24 and 26-42 under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto (U.S. Patent No. 7,373,140) in view of Flowers (U.S. Patent No. 5,533,174).

The assignee hereby requests review of the final rejection prior to filing an appeal brief for the reasons set forth below because the final rejection fails to make a *prima facie* case of unpatentability, and there is clear error in the rejections of these claims. Any fees due should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012558.

Claims 24 and 26-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto (U.S. Patent No. 7,373,140) in view of Flowers (U.S. Patent No. 5,533,174). Each of independent claims 24, 31, 34, and 40 requires a server “comparing the font identifiers in the text data with the fonts in the capabilities list of a designated device” or a similar variant. The Final Office Action appears to allege that Flowers discloses the claimed comparing (Final Office Action, page 3, lines 1-3). However, this allegation cannot be correct because the cited process in Flowers takes place at the client printer, not at a server, as is specifically required by the claims. None of Matsumoto, Flowers, or their combination contains a teaching of the comparing feature. Therefore, a *prima facie* case for the unpatentability of the claims has not been made. Because of this clear error in failing to provide a *prima facie* case, the § 103 rejections of the claims should be withdrawn.

The Flowers system fails to teach a server performing the claimed comparison. Col. 5, lines 5-15 of Flowers states:

When a client is instructed to display or print a particular data file, it determines if the user has selected a font which exists in font storage 18. If user has, the client sends to the font server 16 a make font request which identifies the selected font by name (step 42). The request also includes a "font object" identifier, which is a shortened name that the client and the server can then use to refer to the font selected for this application. The make font request may further include various customizing requirements, such as orientation, language-specific characters, and so forth as discussed below with reference to FIG. 4. (emphasis added)

In Flowers, the printer is the client. The printer has already received the document to be printed by the time font data is considered. When a client (printer) is instructed to print a file, the client determines if the font specified in the file is available from a font server. If the font is available, then the client makes a request to the font server, which may then provide the font. (The advisory action appears to argue that the font server that is making the determination. However, col. 5, lines 5-6 of Flowers clearly states that the client makes the determination and sends the

request.) As noted in paragraph [0007] of the application at issue, this is exactly the type of time and resource consuming communication from the client (*e.g.*, a mobile device) that claim 1 seeks to avoid. Because the client determines if the font specified in the file is available from a font server, Flowers clearly does not teach a server comparing the font identifiers in the text data with the fonts in the capabilities list of the designated device.

The disclosure of Matsumoto also does not contain a teaching of the claimed comparing step and, therefore, cannot cure the deficiency in the Flowers disclosure. The system of Matsumoto includes a mechanism where missing fonts are provided to a wireless client based on the wireless client's selection of a language to use. This feature is shown in each of the data flow diagrams: FIGS. 4, 6, 8, and 10. Annotated FIG. 4 is included below for convenience:

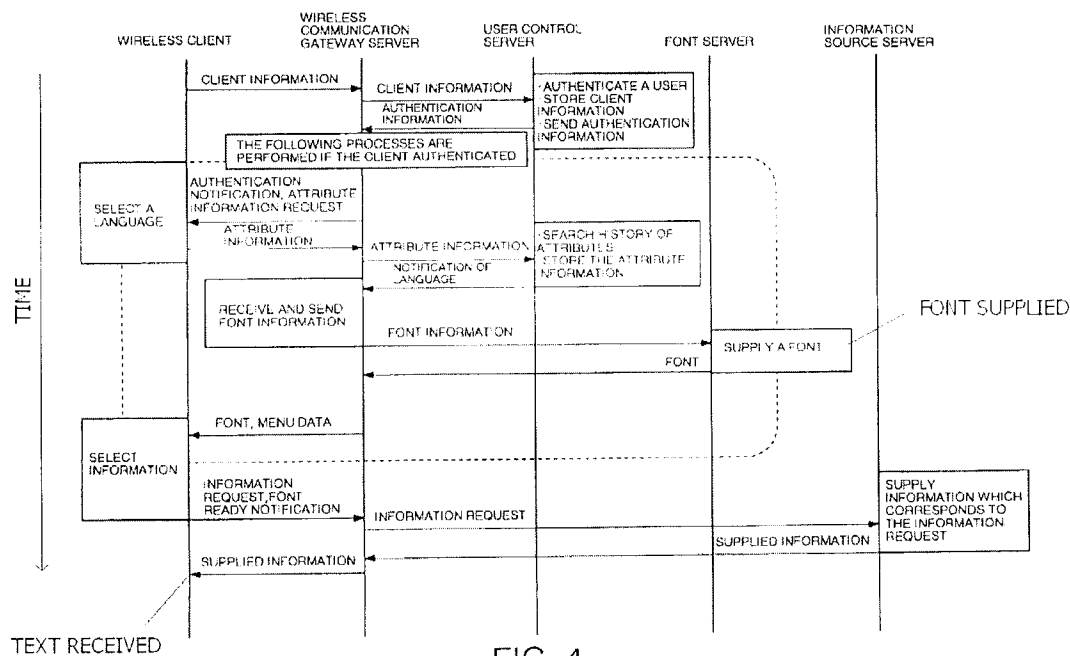


FIG. 4

As shown in FIG. 4 and described at col. 6, line 48 – col. 7, line 27, the client specifies a language and provides the selected language to the gateway server as attribute information. The attribute information is forwarded to a user control server that returns font information related to

the selected language to the gateway server. The gateway server then supplies the font to the wireless client based on the selected language rather than any received text data. After the client has received the font data, the wireless client makes requests to the information source server for data. Because the fonts are received by the wireless client prior to the text being received, it is impossible for Matsumoto to teach a comparison of font identifiers in the text data with the fonts in the capabilities list of the designated device in order to have the lacking fonts needed to display the text transferred to the device.

Because neither of the cited references teaches a server comparing the font identifiers in the text data with the fonts in the capabilities list of the designated device to determine the font identifiers for which the designated device lacks font structure data, a *prima facie* case for the rejection of the claims has not been made. A failure to make a *prima facie* case is clear error for which the § 103 rejection of claim 24 and the other independent claims must be withdrawn.

### **CONCLUSION**

For the foregoing reasons, assignee submits that the pending claims are allowable. Therefore, it is respectfully requested that this case pass to issuance.

Respectfully submitted,

By: \_\_\_\_\_

Joseph M. Sauer (Reg. No. 47,919)  
Jones Day  
North Point, 901 Lakeside Avenue  
Cleveland, Ohio 44114  
(216) 586-7506